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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,767	07/06/2004	Johan George Kloosterboer	NL020031	7140

24737 7590 06/19/2006

PHILIPS INTELLECTUAL PROPERTY & STANDARDS  
P.O. BOX 3001  
BRIARCLIFF MANOR, NY 10510

EXAMINER
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MCCLENDON, SANZA L

ART UNIT	.PAPER_NUMBER
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1711

DATE MAILED: 06/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/500,767

Applicant(s)

KLOOSTERBOER ET AL.

Examiner

Sanza L. McClendon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16-18 is/are allowed.
- 6) ☒ Claim(s) 1-3 and 6-9 is/are rejected.
- 7) ☒ Claim(s) 2-5 and 10-15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. In response to the Amendment received on March 29, 2006, the examiner has carefully considered the amendments. The examiner acknowledges the addition of new claims 13-18. The claim rejection under 35 U.S.C. § 112, 2nd paragraph for claims 3-4 and 11-12 have been overcome by the amendment and has hereby been withdrawn for consideration.

### ***Terminal Disclaimer***

2. The terminal disclaimer filed on March 29, 2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of Application number 09/932,701 (USPG Pub 2002/0033547) has been reviewed and is accepted. The terminal disclaimer has been recorded.

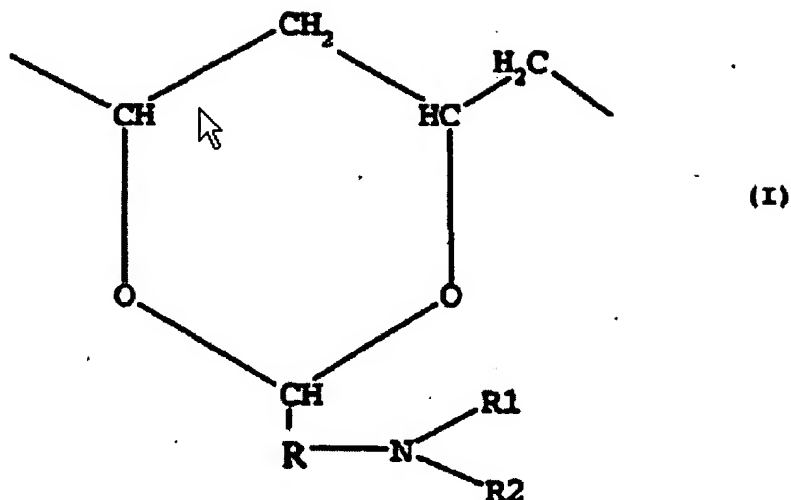
### ***Response to Arguments***

3. Applicant's arguments, see Arguments/Remarks, filed March 29, 2006, with respect to claims 1-12 have been fully considered and are persuasive. The rejection of claims 1-12 under 35 USC 102(e) as being anticipated by Koolsterboer et al has been withdrawn.

4. Applicant's arguments filed Arguments/Remarks have been fully considered but they are not persuasive with respect to claims 1-2 and 6-9 under 35 USC 102(b) as being anticipated by Herbrechtsmeier (WO 98/42497. Applicant appears to be arguing that said reference does not address the problem of shrinkage and does not disclose use of a compound having at least two cationically polymerizable cyclic ether groups, which only show signs of gelation when at least 30% of the conversion is achieved in the mold once relevant curing conditions take place. However the reference teaches using a polyvinyl alcohol having cyclic acetal groups:

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Wherein it is known in the art that cyclic acetal of various ring sized polymerize with cationic initiators, where trioxoanes and dioxolanes are important—see Yagci et al (PTO 892). Herbrechtsmeier et al teaches said polyvinyl alcohol comprises at least 80% of the groups as found in the above formula. The arguments regarding said reference not addressing the problem of shrinkage is moot since said shrinkage problem is not claimed.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-2 and 6-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Herbrechtsmeier (WO 98/42497).

Herbrechtsmeier et al teaches molding processes comprising the steps:

- (a) dispensing prepolymer material into a female mold half;
- (b) mating a male mold half to the female mold half;
- (c) applying radiation to crosslink and/or polymerize the prepolymer material to form a molding;
- (d) separating the male mold half from the female mold half;
- (e) washing the molding to remove unreacted prepolymer;
- (f) ensuring the molding is adjacent a selected mold half;
- (g) grasping the molding in a central area to remove the molding from the selected mold half;
- (h) depositing an acceptable molding into packaging;
- (i) cleaning the male and female mold halves; and
- (j) indexing the male and female mold halves to a position for dispensing prepolymer.

Said prepolymer material comprises a prepolymer, wherein said prepolymer can have crosslinkable cationic groups—see page 36. Said prepolymer can be included with a vinylic comonomer—see page 34. Said molding process according to Herbrechtsmeier et al can be used to make contact lens materials. The inventions of claims 1-2 and 6-9 are anticipated by the reference.

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***Allowable Subject Matter***

7. Claims 3-5 and 10-15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter: The prior art fails to teach a method of manufacturing a replica as found in instant claim 1, wherein the resin is a compound having the formula as found in claims 3-5 or compounds such as found in claims 10-12. The prior art fails to teach, alone or in combination, a method as found in claims 1 using a polymerizable resin composition comprising the solutions as found in claims 13-15.

9. Claims 16-18 are allowed.

10. The following is an examiner's statement of reasons for allowance: The prior art fails to teach, alone or in combination, a replica obtained by UV-light initiation of a composition comprising the solution as found in claims 16-18.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

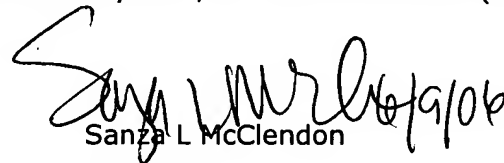
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanza L. McClendon whose telephone number is (571) 272-1074. The examiner can normally be reached on Monday through Friday 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Sanza L. McClendon', with a date '6/9/06' written to the right of the signature.

Sanza L. McClendon

Examiner

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